

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|--------------------------------|---|-----------------------|
| In re Patent Application of:   | ) |                       |
| MARINET ET AL.                 | ) | Examiner: C. A. REVAK |
|                                | ) |                       |
| Serial No. 09/995,258          | ) | Art Unit: 2131        |
|                                | ) |                       |
| Filing Date: NOVEMBER 27, 2001 | ) | Attorney Docket No.   |
|                                | ) | 00RO27254350          |
| For: RANDOM SIGNAL GENERATOR   | ) |                       |
|                                | ) |                       |

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Responsive to the final Office Action of August 16, 2007, and in connection with the Notice of Appeal filed concurrently herewith, please consider the remarks set out below.

REMARKS

Applicants thank the Examiner for correctly withdrawing the objections to the Drawings and Specification of the present application. Based upon the arguments presented below, Applicants respectfully request the Pre-Appeal Conference Panel reconsider and withdraw the Examiner's rejections of the claims.

I. The Claimed Invention

Independent Claim 17 is directed to a random signal generator. The random signal generator comprises an electronic noise source comprising a folded MOS transistor having a drain-

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source current with a random component. The folded MOS transistor comprises a drain and a source with a folded channel defined therebetween. The random signal generator further comprises a circuit for generating a digital signal based upon the random component.

Independent Claim 25 is directed to a random signal generator circuit comprising a plurality of the random signal generators of Claim 17, and a logic circuit connected to the plurality of random signal generators for combining the digital signals for generating a digital number. Independent Claim 42 is a method counterpart to Claim 17.

## **II. The Claims Are Patentable**

The Examiner rejected independent Claims 17, 25, and 42 over Morozumi. Morozumi discloses a solid-state imaging sensor comprising a sensing cell, as depicted in Figures 14a-b. The sensing cell comprises an S-shaped channel region that serves as a photosensitive layer for the imaging sensor and stores photo-excited current. (Col. 10, lines 13-17). As depicted in Figure 18 of Morozumi, the relationship between photosensitive current generated and the corresponding incident light on the imaging sensor cell is substantially linear.

In contrast, independent Claim 17, for example, recites a folded MOS transistor having a drain-source current with a random component. Morozumi does not disclose any source for generating a random signal as in the claimed invention. The

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imaging sensor of Morozumi depends on predictable currents being generating in the channel of the sensing cell to generate accurate signals relating to the image being sensed. The accompanying circuitry of the imaging sensor produces a predictable and accurate signal from the generated photosensitive current. (Col. 2, lines 63-68).

Indeed, the portion of Morozumi cited by the Examiner recites that "the charge generated in the photo-sensitive member is directly proportional to the incident light, the sequential sampling of the adjacent sensing cells allows for the conversion of photo images into electrical signals." (Col. 3, lines 18-22). Therefore, independent Claim 17 is patentable over the prior art. Independent Claims 25 and 42 are similar to Claim 17 and are patentable for similar reasons.

The Examiner also contended that the claim recitation of a "random component" is an intended use of the claimed invention and gave it no patentable weight. The Examiner also contended that Morozumi discloses the claim feature since it is capable of performing the claim feature.

Applicants respectfully note that if a claim element is not expressly disclosed by the prior art, the reference must inherently disclose the claim element to anticipate it. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). The court went on to state that:

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[t]o establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q.2D (BNA) at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)). *Id.* at 745. (emphasis added)

A person of ordinary skill in the art would not appreciate the needed modifications to Morozumi to produce the claimed invention. Indeed, Morozumi is directed to an entirely different field, i.e. predictable and regular current generation for an imaging sensor. Therefore, for this reason also, independent Claims 17, 25, and 42 are patentable over the prior art.

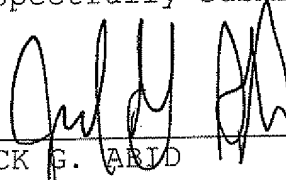
Moreover, Applicants submit that a folded MOS transistor having a drain-source current with a random component, as recited in the independent claims, is not intended use, as contended by the Examiner. Applicants submit that this claim feature defines a distinct structure of the folded MOS transistor that produces a random component in the drain-source current. Differently, the structure of Morozumi produces a consistent and proportional current.

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Accordingly, it is submitted that independent Claims 17, 25, and 42 are patentable over the prior art. Their respective dependent claims, which recite yet further distinguishing features, are also patentable over the prior art and require no further discussion herein.

Respectfully submitted,



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